

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ZVI YANIV, NALIN KUMAR and NATHAN POTTER

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Appeal No. 2000-1754  
Application No. 08/748,893

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ON BRIEF

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Before GROSS, BARRY, and BLANKENSHIP, Administrative Patent Judges.  
GROSS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 through 23, which are all of the claims pending in this application.

Appellants' invention relates to an apparatus and method for testing a display panel. The apparatus includes a set of compliant bumps mounted on an interface for electrically connecting the interface with pads on the display panel. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. An apparatus adaptable for testing an electric device comprising:

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an interface having electrical paths adaptable for coupling to display circuitry; and

one or more compliant bumps mounted on said interface and connected to said electrical paths, wherein said one or more compliant bumps are adaptable for making contact with pads on said electric device wherein said electric device is a display panel.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Ardezzzone	3,832,632	Aug. 27, 1974
Feigenbaum et al. (Feigenbaum)	5,378,982	Jan. 03, 1995
Hawthorne et al. (Hawthorne)	5,764,209	Jun. 09, 1998
		(filed Feb. 22, 1995)

Claims 1, 7, and 14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hawthorne.

Claims 1 and 3 through 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Feigenbaum in view of Ardezzzone and Hawthorne.

Reference is made to the Final Rejection (Paper No. 9, mailed July 19, 1999) and the Examiner's Answer (Paper No. 12, mailed March 1, 2000) for the examiner's complete reasoning in support of the rejections, and to appellants' Brief (Paper No. 11, filed December 21, 1999) and Reply Brief (Paper No. 13, filed May 8, 2000) for appellants' arguments thereagainst.

#### OPINION

We have carefully considered the claims, the applied prior art references, and the respective positions articulated by

appellants and the examiner. As a consequence of our review, we will reverse both the anticipation rejection of claims 1, 7, and 14 and also the obviousness rejection of claims 1 and 3 through 23.

We turn first, as we must, to the rejection under 35 U.S.C. § 102. "It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim." *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). *See also Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). The examiner asserts (Final Rejection, pages 5-6) that Hawthorne discloses each and every element of claims 1, 7, and 14, pointing, in particular, to element 120 to meet the claimed compliant bumps. Appellants argue (Brief, page 4) that Hawthorne's element 120 is a flexible tape with metal traces formed thereon, not compliant bumps. We agree with appellants.

The examiner (Answer, pages 3-4) quotes a dictionary definition of "bump," and concludes that Hawthorne's flexible tape meets the aforementioned definition. However, the examiner fails to explain how he reached such a conclusion. We do not understand how the flexible tape complies with the quoted definition. Hawthorne shows no "relatively abrupt convexity or

protuberance." At best, Hawthorne shows a gradually curved convex surface with metal traces formed thereon. Thus, Hawthorne fails to disclose every element of the claim, and we cannot sustain the anticipation rejection of claims 1, 7, and 14.

Regarding the obviousness rejection of claims 1 and 3 through 23, the examiner (Final Rejection, pages 7-8) describes the disclosures of the three references and then (Final Rejection, pages 8-9) draws the conclusion that it would have been obvious to combine the three references,

because each is used to test an electric device such as a display device using contact bump or bumps mounted on a support structure and interfaced to a testing device. Moreover, the method described in claim 7 is considered the obvious method of using the apparatus and the limitations of claims 3-6, 8-13 and 15-23 are considered inherent in the above combination or within the normal range of operating the apparatus of the above combination.

The examiner points to no specific portions of Ardezzone and Hawthorne for teachings or suggestions to modify Feigenbaum and provides no explanation as to why it would have been obvious to do so.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is required to make the factual determinations set forth

in *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Such determinations include the scope and content of the prior art and differences between the prior art and the claims at issue. Further, under *Graham* the examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. *Uniroyal, Inc. v. Rudkin-Wiley*, 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), *cert. denied*, 488 U.S. 825 (1988); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. *Note In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Furthermore, "[t]hat knowledge can not come from the applicant's invention itself." *Oetiker*, 977 F.2d at 1447, 24 USPQ2d at 1446.

In the present case, the examiner determined the scope and content of the prior art (though we disagree with the examiner's findings as to the existence of compliant bumps in Hawthorne's device) and stopped short. Nowhere does the examiner determine

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the differences between the prior art and the claims at issue nor provide a reason from some teaching, suggestion or implication in the prior art why the skilled artisan would have been led to modify the prior art to arrive at the claimed invention.

Appellants argue (Brief, page 5) that the examiner has relied solely upon hindsight reconstruction of the invention from the prior art, and we must agree. Since the examiner has set forth no teachings, suggestions, or line of reasoning for the combination, what else could the examiner have relied upon other than impermissible hindsight? In light of this, we have no choice but to find that the examiner has failed to present a *prima facie* case of obviousness. Consequently, we cannot sustain the rejection of claims 1 and 3 through 23 over Feigenbaum, Ardezzone, and Hawthorne.

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CONCLUSION

The decision of the examiner rejecting claims 1, 7, and 14 under 35 U.S.C. § 102(e) and claims 1 and 3 through 23 under 35 U.S.C. § 103 is reversed.

REVERSED

ANITA PELLMAN GROSS	)	
Administrative Patent Judge	)	
	)	
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	)	BOARD OF PATENT
LANCE LEONARD BARRY	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
HOWARD B. BLANKENSHIP	)	
Administrative Patent Judge	)	

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